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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/794,154	02/03/97	SCHWARTZ	A SWTZ110464

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EXAMINER

NERBUN, P

ART UNIT

3408

PAPER NUMBER

15

DATE MAILED: 03/26/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/794,154

Applicant(s)

Schwartz et al

Examiner

Peter Nerbun

Group Art Unit

3408



☒ Responsive to communication(s) filed on Feb 3, 1997

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1, 2, 13, 14, 37, 38, 40, 41, 48-50, and 58-65 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 2, 37, 38, 40, 41, 50, and 58-65 is/are rejected.

☒ Claim(s) 13, 14, 48, and 49 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

1. Claim 37 contains the trademark/trade name "Kitecko Ultrasound Standoff Pad". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name.

2. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

3. Claims 1, 2, 37, 38, 40, 41, 50, 58-60, 64, and 65, insofar as definite, are further rejected under 35 U.S.C. § 103 as being

unpatentable over Runckel in view of Chen, taken as applied in paper no. 8 of parent application SN 08/377,257. The patent to Runckel discloses goggles having a frame 14, 16, 18, Fig. 1 including a transparent portion. A sealing pad 42 is designed to conform to the orbits of the user's eyes. To construct the goggles of Runckel with the sealing pad being formed from a gelatinous elastomer as suggested by Chen (see column 6, lines 37-61 and column 7, lines 8-11 -- in particular, column 6, lines 58-61) would have been obvious since Chen states that gelatinous elastomers may be used in the construction of optical devices. Regarding claim 15, note that Chen states that the gelatinous elastomer composition "can be additionally surrounded with film...". With regard to claims 2, 37, and 40, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select a gelatinous polymer having a degree of compliancy within the range recited since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

4. Claims 61-63 are rejected under 35 U.S.C. § 103, insofar as definite, as being unpatentable over Nishiyama in view of Chen, taken as applied in paper no. 8 of parent application, SN 08/377,257. The patent to Nishiyama discloses goggles comprising a frame 10, Fig. 1A including a transparent portion

adapted to cover the user's eyes, and a sealing pad 41 adjacent to the frame, said sealing pad comprising a compliant and resiliently deformable urethane or neoprene elastomer (see column 3, lines 1-2) surrounded by a film (see column 7, lines 8-11). To construct the goggles of Nishiyama with the sealing pad being formed from a gelatinous elastomer that is surrounded by a film as suggested by Chen (see column 6, lines 37-59 and column 7, lines 8-11 -- in particular, column 6, lines 58-59) would have been obvious for the reason given hereinabove. With regard to claims 2 and 37, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select a gelatinous polymer having a degree of compliancy within the range recited the reason given hereinabove.

5. Claims 13, 14, 48, and 49 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. This is a continuation of applicant's earlier application S.N. 08/377,257. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds or art of record in the next Office action if they had been entered in the earlier application.

Accordingly, THIS ACTION IS MADE FINAL even though it is a first action in this case. See M.P.E.P. § 706.07(b). Applicant is

Serial Number: 08/794,154
Art Unit: 3408

-5-

reminded of the extension of time policy as set forth in 37
C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Nerbun, whose telephone number is (703)-308-0955. The examiner can normally be reached on Monday-Thursday from 8:30 to 6:00. The examiner also can be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cliff Crowder, can be reached on (703)-308-0949. The fax phone number for this group is (703)-308-7766.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)-308-0861.

Peter Nerbun
March 24, 1997



PETER NERBUN
PRIMARY EXAMINER
GROUP 3400